

## **REMARKS**

In this Response, claims 1 and 4-17 are amended. New claim 18 is added. No new matter is introduced by the amendments. Accordingly, claims 1 and 3-18 are pending in the present application. Applicants respectfully request reconsideration of the application in view of the above amendments and remarks made herein.

### **I. Rejections Under 35 U.S.C. § 101**

Claims 4, 5, 7-12 and 14-17 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter, for the reasons set forth on pages 3-4 of the Office Action.

In the Office Action, the Examiner states: "Claims 4, 5, 7-12 and 14-17 are for a system for for [sic] analyzing and utilizing intellectual property (IP) information. However, all of the elements claimed could be reasonably interpreted in light of the disclosure by an ordinary artisan as being software alone, and thus directed to functional descriptive material [software *per se*], which is non-statutory."

Amended claims 4, 5, 7-12 and 14-17 are believed to be directed to statutory subject matter since the claims are directed to a "computer-based system ..."

As stated in MPEP § 2106.01, "computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized." In contrast, the claimed computer-based systems define structural and functional interrelationships between computer software and hardware components which permit the system's functionality of analyzing and utilizing IP information to be realized, and thus are statutory.

For the above reasons, amended claims 4, 5, 7-12 and 14-17 are believed to be directed to statutory subject matter and therefore satisfy 35 U.S.C. § 101.

Withdrawal of the rejections under 35 U.S.C. § 101 is respectfully requested.

## II. Rejections Under 35 U.S.C. § 102

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,721,910 issued to *Unger et al.* (hereinafter "*Unger*"), for the reasons set forth on pages 5-8 of the Office Action.

With regard to amended claim 1, Applicants respectfully submit that *Unger* does not teach "(d) if the first IP information is determined to include IP information that is not related to a project, discarding said IP information; (e) if the first IP information is determined to include IP information that is related to the project, determining whether a request for detailed information has been made from the research center PCs".

*Unger* (col. 1, line 8) discloses that "[t]he present invention is a database." *Unger* (col. 2, lines 58-65) discloses: "The present invention is a database system which contains a hierarchical model of a complex business, scientific or technical entity or specialty and the associated technical documents, such as patents or scientific or technical publications, or abstracts of those patents or publications, which reflect each aspect of that model. Each technical document may be assigned to one or more categories within the hierarchical model."

That is, *Unger* merely teaches a database that contains a hierarchical model of an entity and associated technical documents that are assigned to one or more categories in the hierarchical model. Applicants respectfully submit that *a database containing technical documents that are assigned to one or more categories within a hierarchical model* is not analogous to "(d) if the first IP information is determined to include IP information that is not related to a project, discarding said IP information; (e) if the first IP information is determined to include IP information that is related to the project, determining whether a request for detailed information has been made from the research center PCs", as recited in claim 1.

Therefore, for at least the above reasons, *Unger* does not anticipate claim 1. Applicants respectfully submit that inasmuch as claim 3 is dependent on claim 1, and claim 1 is patentable over *Unger*, claim 1 is patentable as dependent on a patentable independent claim.

Withdrawal of the rejections under 35 U.S.C. § 102(b) is respectfully requested.

### III. Rejections Under 35 U.S.C. § 103

Claims 4-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Unger* in view of U.S. Patent No. 5,862,223 issued to *Walker et al.* (hereinafter "*Walker*"), for the reasons set forth on pages 9-22 of the Office Action.

With respect to claims 4 and 11, Applicants respectfully submit that neither *Unger* nor *Walker*, alone or in combination, teach or suggest "wherein the research center PCs are coupled to the IP information extraction unit and wherein the research center PCs determine whether the extracted IP information includes IP information that is related to a project, and if the extracted IP information is determined to include IP information that is related to the project, requesting detailed information corresponding to the IP information that is related to the project from the IP information extraction unit, and if the extracted IP information is determined to include IP information that is not related to a project, discarding said IP information."

As stated above, *Unger* (col. 2, lines 58-65) discloses a database system that contains a hierarchical model of an entity and associated technical documents, such as patents or other publications, or abstracts of those patents or publications, which reflect each aspect of that model. As taught by *Unger*, each technical document may be assigned to one or more categories within the hierarchical model.

Applicants respectfully submit that *a database containing technical documents that are assigned to one or more categories within a hierarchical model* is not analogous to "wherein the research center PCs are coupled to the IP information extraction unit and wherein the research center PCs determine whether the extracted IP information includes IP information that is related to a project, and if the extracted IP information is determined to include IP information that is related to the project, requesting detailed information corresponding to the IP information that is related to the project from the IP information extraction unit, and if the extracted IP information is determined to include IP information that is not related to a project, discarding said IP information", as recited in claims 4 and 11.

*Walker* (col. 6, lines 56-64) discloses: "the present invention provides a method and apparatus for an expert seeking to sell his services to more efficiently find a client,

allow the client to certify and authenticate the expert's qualifications, allow the client to hire the expert under specific terms and conditions for a specific assignment, and, if desired by either party, have the service provider guarantee payment to the expert for the expert services to be provided while also guaranteeing the buyer's satisfaction with the expert service." That is, *Walker* discloses an expert matching method and apparatus for managing communications between an expert having particular qualifications and an end user seeking a solution to an expert request.

*Walker's expert matching method and apparatus for managing communications between an expert having particular qualifications and an end user seeking a solution to an expert request* is not analogous to "wherein the research center PCs are coupled to the IP information extraction unit and wherein the research center PCs determine whether the extracted IP information includes IP information that is related to a project, and if the extracted IP information is determined to include IP information that is related to the project, requesting detailed information corresponding to the IP information that is related to the project from the IP information extraction unit, and if the extracted IP information is determined to include IP information that is not related to a project, discarding said IP information", as recited in claims 4 and 11. Therefore, *Walker* fails to cure the deficiencies in *Unger*.

Therefore, for at least the above reasons, claims 4 and 11 are believed to be patentable and non-obvious over the combination of *Unger* and *Walker*. Applicants respectfully submit that inasmuch as claims 5-10 are dependent on claim 4, and claims 12-17 are dependent on claim 11, and claims 4 and 11 are patentable and non-obvious over the cited references, claims 5-10 and 12-17 are patentable as dependent on patentable independent claims.

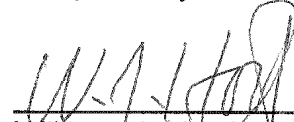
In view of the foregoing, the rejections under 35 U.S.C. § 103(a) should be withdrawn.

**CONCLUSION**

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

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